





THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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1/17/02  
2119d

In re Application of

Atty. Docket

JOHANNES F.M. D'ACHARD VAN ENSCHUT

PHN 16,219A

Serial No. 09/022,132

Group Art Unit: 3713

Filed: FEBRUARY 11, 1998

Examiner: C. White

METHOD FOR OPERATING A VIDEO GAME WITH BACKFEEDING A VIDEO IMAGE OF A  
PLAYER, AND A GAME ARRANGED FOR PRACTISING THE METHOD

Commissioner for Patents  
Washington, D.C. 20231

APPEAL BRIEF

Sir:

Appellant's brief on appeal as follows:

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REAL PARTY IN INTEREST

The real party in interest is U.S. Philips Corporation, having  
an office at 580 White Plains Road, Tarrytown, NY 10591.

RELATED APPEALS AND INTERFERENCES

To the best of Appellants knowledge and belief, there are no  
related appeals or interferences.

## STATUS OF CLAIMS

Claims 1-8 were originally filed with the application. In a Preliminary Amendment filed concurrently with the application, Claims 3-5 and 8 were amended to cancel multiple dependencies. Claims 5 was thereafter cancelled and Claims 1 and 6 were amended in response to a November 22m, 1999 Office Action. Claims 1 and 6 were again amended in an After Final Amendment on August 15, 2000 in response to a Final Office Action dated April 5, 2000. These amendments were rejected as requiring a further search, so a Continuing Prosecution Application (CPA) was submitted on September 5, 2000 requesting entrance of the August 15, 2000 After Final Amendment. No further amendments to the claims have been made. Claims 1-4 and 6-8 were thereafter amended and a Claim 9 was added in response to an Office Action dated October 3, 2000. Lastly, claims 1 and 6 were amended in an Amendment After Final Action on August 22, 2001 in response to a Final Office Action dated May 22, 2001. An Advisory Action dated September 4, 2001 states that the claims as so amended will be entered. Claims 1-4 and 6-9 as so amended, are the subject of this appeal.

## STATUS OF AMENDMENTS

A Final Office Action of May 22, 2001 and an Advisory Action of September 4, 2001 was received maintaining rejection of Claims 1-4

and 6-9. This Appeal Brief is in response to that Final Office Action and the Advisory Action.

#### SUMMARY OF THE INVENTION

The present invention relates to a method and system for providing a gaming environment to current game players. To that end, the game system provides a picture of the currently highest scoring player during the game playing session. It must be noted that this is not just a static display of players that had a high score at the end of a game, as for instance shown in U.S. Patent No. 4,710,873 to Breslow. As stated in the present patent application, "the display could take up the images of the driver that actually leads the pack ..." (See, for example, last paragraph at bottom of page 3 and continuing onto page 4 and FIG. 2, element 72.) This system is one way in which a more direct challenge may be presented to the other players during game play. This system further provides the present player displayed with the additional gratification of knowing that all other players see him identified as the current lead player.

#### ISSUE

Whether Claims 1-4 and 6-9 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 4,521,014 to Sitrick ("Sitrick") in view of U.S. Patent No. 4,710,873 to Breslow ("Breslow").

#### GROUPING OF CLAIMS

Claims 1 and 6 stand alone. Claims 2-4 and 9 stand or fall together with Claim 1. Claims 7 and 8 stand or fall together with Claim 6.

#### ARGUMENT

Claims 1-4 and 6-9 are said to be anticipated by Sitrick in view of Breslow.

In the Office Action it is stated that Sitrick discloses all the features of Claim 1, except for the feature that the image of the highest-scoring player is shown during play. Breslow is then cited for teaching the display of the highest scorer's image and score before or after game play. Both the abstract and Fig. 4e of Breslow is cited as support for this feature.

However, neither Sitrick nor Breslow alone or in combination teach "displaying ... the video image of the currently high-scoring player ... during the particular session of the video game ..." This is evident from the description of Figure 4e in the text of Breslow. Specifically, Col 5, lines 39-42 states that (emphasis provided) "After the play of the game ... the play of the game ends with a display of the top six scores as indicated in Fig. 4e". **Clearly,**

this does not teach or suggest anything about showing images or scores during play.

Apparently the provided argument is that the combination of the teachings of Sitrick together with Breslow would give a system in which the highest scorer's image and score is shown during play. This assertion finds no support in either of Sitrick or Breslow. The display of the highest scorer's image in Breslow is in a high score list (Figure 4e). Sitrick shows using a video representation of the player during game play as the participating game object (e.g., on the cars).

Item 66 in Figure 4d of Breslow is noted in the Office Action as evidence that the score of the current player is shown during play. The Office Action further states that it is obvious to modify this system to show the image and score of the highest scoring player. However, nowhere within the four corners of either Breslow or Sitrick is there even the hint that would prompt the skilled person to make this modification.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

Sitrick displays images of players during play in order to allow players to distinguish their character from others (column 1, lines 44-49 of Sitrick). In contrast, Breslow shows the high score list to show game results. Breslow's system is aimed at enhancing the interactivity of the game and to make players more recognizable in the game play (see, Col. 1, lines 45-49 of Breslow). This is a very different problem than providing a direct challenge to top players during game play. It is unclear how a combination of these features would result in a gaming system that prominently shows an image of the highest scoring player during play so as to enhance the realism of and competition in the game as required by Claim 1 and as substantially required by Claim 6.

The suggestion that the skilled person would make this modification since it would make the competition "more realistic and exciting" does not suggest or require this particular modification. In fact, this statement appears to require impermissible hindsight, since there are many ways to make a game more exciting. The solutions required by either of Claims 1 and 6 are amongst many others that may accomplish the same result of an exciting game and yet this does not render them unpatentable.

The Advisory Action further states that it is "an obvious matter of choice well within the capability of Breslow" and that "Breslow is functionally capable of achieving this feature." Yet, this again is

not the test for obviousness. It is not sufficient that a prior art reference may be modifiable to perform the present inventive elements. There must be some teaching in the prior art for the desirability or a motivation, must be suggested by the prior art (see discussion above). Yet, again there is no teachings recited in either of the prior references suggesting or even applicable to these inventive features.

Based on the foregoing, the Applicant respectfully submits that independent Claims 1 and 6 are patentable over Sitrick in view of Breslow and notice to this effect is earnestly solicited.

As noted, Claims 2-4 and 9 stand or fall together with Claim 1, and are thus also allowable. Claims 7 and 8 stand or fall together with Claim 6, and are thus also allowable.

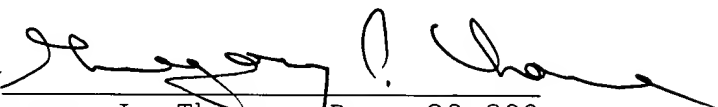


CONCLUSION

Claims 1-4 and 6-9 are patentable over Sitrick in view of Breslow.

Thus the Examiner's rejection of Claims 1-4 and 6-9 should be reversed.

Respectfully submitted,

By   
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October 23, 2001

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited this date  
with the United States Postal Service as first-class mail in an envelope addressed to:  
COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

On OCTOBER 23, 2001

By Neemi Chapa

## APPENDIX

### CLAIMS ON APPEAL

1. (Four times amended) A method for operating a multi-player video game, the method comprising:

enabling each player of multiple players to interact with a gaming environment,

machine-detecting a score and/or performance of each player in a particular session of the video game,

backfeeding into the gaming environment a video image of a currently high-scoring player, and

displaying the gaming environment, and the video image of the currently high-scoring player of the multiple players in a prominent location, during the particular session of the video game.

2. (Amended) A method as claimed in Claim 1, furthermore comprising

ranking high-scoring players in respectively successive playing sessions, and

providing a representation of one or more of the high-ranking players for display in subsequent playing sessions, based on the ranking.

3. (Twice Amended) A method as claimed in Claim 1, for use in a multiple player environment, wherein the video image of select players of the multiple players is selectively cross-wise fed back to the multiple players.

4. (Twice Amended) A method as claimed in Claim 1, wherein the video image of select players of the multiple players is made part of a composite image with one or more selected items taken from memory.

6. (Four times amended) A video game system being arranged for running a multi-player video gaming environment, comprising

a user interface that is configured to enable each player of multiple players to interact with the gaming environment,

a detector that is configured to detect a score and/or performance of each player during a particular session of the video game,

a backfeeding device that is configured to:

backfeed into the gaming environment a video image of a currently high-scoring player of the multiple players, and

a display that is configured to display the gaming environment, and the video image of the currently high-scoring player in a

relatively prominent position, during the particular session of the video game, and

one or more cameras that are configured to provide the video image of each player.

7. (Amended) A system as claimed in Claim 6, furthermore comprising ranking means for relatively ranking players in respectively successive playing sessions, and control means fed by the ranking means for providing video images of the high-ranking players to subsequent playing sessions.

8. (Twice Amended) A system as claimed in Claim 6, arranged for implementing a multiple player gaming environment, and having cross-wise communication means for selectively cross-wise backfeeding the video image to multiple players.

9. A method as claimed in Claim 1, further allowing the player to suppress during the session a presentation of the actual score, performance and/or video image to the backfeeding.